

REMARKS/ARGUMENTS

35 USC §103(a)

Reconsideration and allowance are requested of Claims 1-5, 8 and 9, which were rejected in the last office action under 35 USC §103(a) as being unpatentable over Decarolis et al in view of Caldwell. Reconsideration and allowance are also requested of Claim 3 which was rejected under 35 USC §103(a) as being unpatentable over Decarolis et al and Caldwell as applied to Claims 1-5, 8 and 9, and further in view of Lin U.S. Patent No. 6,182,916. In addition, reconsideration and allowance are requested of Claim 7 which was rejected under 35 USC §103(a) as being unpatentable over Decarolis et al and Caldwell as applied to Claims 1-5, 8 and 9, and further in view of Seymour. Applicant has submitted a proposed amendment to independent Claim 1 which, as urged below, places the Claims 1-9 in condition for allowance or in better form for consideration on appeal.

In accordance with 37 CFR §1.116, the proposed amendment touches the merits of the application and may be admitted on a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. Applicant amended the claims in a communication filed on May 2, 2005 in response a rejection under 35 USC §102. The examiner has now rejected all of the claims under 35 USC §103(a) based upon newly cited references - Decarolis et al and Caldwell et al. Therefore, this is the first opportunity for Applicant to present an amendment to the claims and to argue allowability to overcome the new ground of rejection based upon these newly cited references.

All of the rejections of the claims under §103(a) are based upon the primary reference of Decarolis et al combined with the secondary reference of Caldwell. In applying the Decarolis reference to the terms of the claims, the examiner has stated that the hub 84 of Decarolis meets the element in Applicant's claims which recite "a secondary spool." In amending the claims, Applicant clarifies that the secondary spool not only has a self-restoring spring wound around it, but the spring is also contained within the spool. Decarolis winds its spring 80 around the hub 84, but this is not a "spool" as that term is used in Applicant's claims since the hub 82 of Decarolis does not contain the spring. Rather, the spring is contained within the casing 72 and washer 78 of Decarolis (col. 3, ll. 20-32). This is important because in order to meet the terms of Applicant's claims, the examiner states that it would be obvious to modify the tape measure of Decarolis to include the endless flexible member 38 of Caldwell. However, by merely replacing the transfer gear 102 of Decarolis with the endless flexible member 38 of Caldwell this would render the tape measure inoperative. Note that in Decarolis the gear 86 is rotatable with the hub 84 *but not the casing 72* which casing is comparable to Applicant's spool 14 that contains the spring 19. Moreover, there is not sufficient room in the Decarolis structure to place an endless flexible member around the gear 86. Note that in Decarolis it is stated that "the circumferential portion of the spring motor is closely spaced to the circumference of the tape reel" (col. 4, ll. 61-63). In Fig. 2, it is clear that there is no room between the gear 86 and the rear portion 22 of the casing 10 of Decarolis to add a flexible member, such as a belt. Substantial modification would have to be made to Decarolis to merely add the endless flexible member 38 of Caldwell,

and there is no suggestion in Decarolis or Caldwell that this can be done. Moreover, the endless flexible member 38 of Caldwell serves an entirely different function in that it powers the reel 24 through a series of gears and pulleys to not only retract the tape under power, but also to extend the tape (col. 4, ll. 41-53). The member 38 of Caldwell does not wind a self-restoring spring.

Unless there is some suggestion or motivation in one of the references that the combination can be made, the law is clear that the combination is not proper. See, In Re Sang-Su-Lee, 277 F.3rd 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002); Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc., 21 F.3d 1068 (Fed. Cir. 1994). These cases, as well as other earlier cases cited therein, unanimously hold that the motivation to combine features of prior art references cannot come from the invention itself but must be *suggested by the prior art*. See, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561 (Fed. Cir. 1987); In Re Geiger, 815 F.2d 687 (Fed. Cir. 1987); Alco Standard Corp. v. Tennessee Valley Auth., 808 F.2d 1490 (Fed. Cir. 1986). In determining whether a person of ordinary skill would have been led to this combination of references, it is improper simply to use that which the inventor taught against its teacher. W. L. Gore v. Garlock, Inc., 721 F2d 1540, 220 USPQ 303 (Fed. Cir. 1983). The examiner has cited no suggestion or motivation in the cited references that the references can be combined to produce Applicant's claimed structure.

Conclusion

Applicant has amended the only independent claim, Claim 1, to clarify the structure of Applicant's tape measure which distinguishes it from the prior art. It is

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respectfully submitted that this response places the claims of Applicant's application in condition for allowance or in better form for consideration on appeal, and therefore further and favorable action on this application is requested. If for any reason the Examiner has any questions about the amended claims or the statements made in this response, Applicant's attorney respectfully requests the Examiner to contact Applicant's attorney by telephone to set up an interview. It is believed that such an interview would be helpful in placing the application in condition for allowance if the Examiner is not already convinced by the amendments and arguments presented in this paper.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 8, 2005.


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